THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM H. VERMEER, ROBERT W. DAMSTETTER
and WILLIAM E. RYAN IV

Appeal No. 97-2480
Application 08/296,122[1]

ON BRIEF

Before STONER, Chief Administrative Patent Judge,
COHEN and ABRAMS, Administrative Patent Judges.

COHEN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claim 14, a new claim entered into the application subsequent to the final rejection. This claim is the sole

[1]Application for patent filed August 25, 1994.

claim remaining in the application.

Appellants' invention pertains to a method of encasing a meat product. An understanding of the invention can be derived from a reading of claim 14, a copy of which appears in the "APPENDIX" to the brief (Paper No. 15).

As evidence of obviousness, the examiner has applied the document specified below:

Meier 4,370,779 Feb. 01, 1983

The following rejection is before us for review.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Meier.

The full text of the examiner's rejection and response to the argument presented by appellants appears in the answer (Paper No. 16), while the complete statement of appellants' argument can be found in the brief (Paper No. 15).

OPINION

In reaching our conclusion on the obviousness issue raised in this appeal, this panel of the board has carefully considered appellants' specification and claim 14, the applied patent,[2] and the respective viewpoints of appellants and the examiner. As a consequence of our review, we make the determination which follows.

We affirm the examiner's rejection of claim 14.

Claim 14 is drawn to a method of encasing a meat product flowing through an encasing machine, the method requiring, inter alia, moving the encased product exiting the machine onto a weighing scale, weighing the encased meat product exiting the machine and comparing the weight thereof to a predetermined target weight, and increasing or decreasing the rate of flow of meat product from a pump to compensate for any variance in weight between the weighed encased product and the

[2] In our evaluation of the applied patent, we have considered all of the disclosure thereof for what it would have fairly taught one of ordinary skill in the art. See In re Boe, 355 F.2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). Additionally, this panel of the board has taken into account not only the specific teachings, but also the inferences which one skilled in the art would reasonably have been expected to draw from the disclosure. See In re Preda 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

target weight, the weight of the encased product being determined by the scale and not computed by the operation of the pump.

The patent to Meier, the evidence of obviousness, informs us that, at the time of appellants' invention, those having ordinary skill in the art were concerned with the size of the whole portion (predetermined quantity) of sausage casing. A method taught by Meier involves, inter alia, the selection of a desired volume portion for a sausage casing, measuring the volume of sausage material dispensed to ascertain the volume of a terminal mass, and flowing the terminal mass of sausage material into a casing to substantially complete the dispensed amount, resulting in the desired portion size. However, the patentee expressly instructs those versed in the art (col. 2, lines 34 through 42) that

> The size of the whole portion, of the terminal mass and of the dispensed sausage material can be measured by weighing, that is, in the form of the corresponding weights. Preferably, however, they are

> measured by volume of the portion, of the terminal mass and of the dispensed material since, in contrast to measuring by weight, measuring by volume poses no problem even under the generally high frequency at which the dispensing steps take place.

As we see it, appellants' claimed method, in effect, involves the application of traditional feedback principles to assure a desired weight, i.e., the method ascertains a difference between a desired weight and an actual weight and compensates for the difference by increasing or decreasing flow.

From our perspective, the overall teaching of Meier, as described above, would have been fairly suggestive of obtaining a desired size of sausage casing by the alternatives of volume measurement or weight measurement.

At this point, we particularly note that this panel of the board presumes skill on the part of those practicing this art. See In re Sovish, 769 F.2d 738, 742, 226 USPQ 771, 774 (Fed. Cir. 1985). With this in mind, it is our opinion that

the method now claimed would have been obvious to one of ordinary skill in the art based upon the explicit teaching by Meier of measuring weight en route to obtaining a desired sausage size, and the common knowledge of feedback principles as likewise exemplified by Meier. To obtain a weight measurement, it is quite apparent to us that those having ordinary skill in the art would have turned to a weighing scale, for example. With a weight analysis as the basis for achieving a desired sausage size, the weight of the encased product, as claimed, would clearly not be computed by a pump.

The argument advanced by appellants in the brief (pages 3 through 5) fails to persuade us that the examiner erred in rejecting claim 14 under 35 U.S.C. § 103. The brief (page 4) addresses the Meier teaching of weighing as conceptual. We disagree. Akin to appellants' broad disclosure of an operative connection (i.e., without structural detail) between the scale and pump to compensate for weight variations, we are convinced that the broad recitation of weight measurement by Meier, in the overall context of the patent's disclosure,

would have informed those versed in the art of the need for a weighing scale to accomplish the weighing function, the scale being positioned to weigh an encased product exiting an encasing machine. Thus, contrary to appellant's concern that Meier lacks the "how and where" a scale would be used (brief, page 4), we are of the view that the Meier teaching would have been highly instructive to one of ordinary skill in the art. Appellants also consider the volume determination method of Meier as not reliable and as less likely to be understood by a machine operator (brief, page 4). Notwithstanding this latter subjective assessment of a volume method, Meier nevertheless explicitly teaches weighing, as an alternative, to those having ordinary skill in the art. For the

preceding reasons, and again contrary to the view advocated by appellants (brief, page 4), we have concluded that the claimed method would have been obvious.

NEW GROUND OF REJECTION

Under the authority of 37 CFR 1.196(b), this panel of the board enters the following new ground of rejection.

Claim 14 is rejected under 35 U.S.C. 112, first paragraph, as being based upon an underlying disclosure which lacks descriptive support for claimed subject matter.

The description requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the enablement requirement. That one skilled in the art might realize from reading a disclosure that something is possible is not a sufficient indication to that person that the something is part of an appellant's invention. See In re Barker, 559 F.2d 588, 591, 194 USPQ 470, 472 (CCPA 1977), cert. denied, 434 U.S. 1064 (1970). The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan

that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language. Further, the content of the drawings may also be considered in

determining compliance with the written description requirement. See Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1562-63, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991) and In re Kaslow, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983).

In the present case, subsequent to the filing of the application, appellants submitted claim 14 (Paper No. 11) with the limitation that the weight of the encased product is determined by a scale "and not computed by the operation of said pump". Appellants did not refer to any basis in the underlying disclosure in support of the noted negative limitation appearing in claim 14, and we can find none. It is evident to us from appellants' remarks (Paper No. 11) that this negative limitation was imported into the present disclosure responsive to and on the basis of the Meier teaching. In light of the above, we conclude that the specified negative limitation adds new matter into the application since it clearly lacks a descriptive basis in the

originally filed specification. See Ex parte Grasselli, 231 USPQ 393, 394 (Bd. App. 1983).

In summary, this panel of the board has affirmed the rejection of Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over Meier. Additionally, we have introduced a new ground of rejection pursuant to 37 CFR 1.196(b).

The decision of the examiner is affirmed.

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR § 1.196(b) provides, "A new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

> (b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner

and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

37 CFR 1.196(b)

BRUCE H. STONER, JR.
Chief Administrative Patent Judge

) BOARD OF PATENT

IRWIN CHARLES COHEN)
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